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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,008	11/21/2003	Clayton R. Younker	802930-0002	3990

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EXAMINER

CARIASO, ALAN B

ART UNIT PAPER NUMBER

2875

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,008

Applicant(s)

CLAYTON R. YOUNKER

Examiner

Alan Cariaso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-26 is/are allowed.
- 6) ☒ Claim(s) 27, 28, 30-32, 35 and 36 is/are rejected.
- 7) ☒ Claim(s) 29, 33, 34 and 37-46 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Reissue Applications

1. Receipt of applicant's preliminary amendment June 1, 2004 is acknowledged. However, in regards to newly submitted claims 19-46, the format of these of these claims is incorrect. In response to this Office Action, applicant should submit the listed claims that include underlining of the text of new claims 19-46, as set forth in 37 CFR 1.173(d2).

2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 6,328,461 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Claim Objections

3. Claims 30-32 and 37-46 are objected to because of the following informalities:

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4. In each of claims 30-32, the term "light" used with "said light housing" was not originally used, but instead was first stated as "a decorative housing" in claim 27. Repeated terms used to designate the same part should be consistent in terminology.
5. Claim 37, line 8, the phrase "a plurality of decorating components carried an outer surface of said decorative housing" appears grammatically incorrect. It appears that a preposition is missing so as to clarify which subject "carries" which object.
6. In each of claims 40-42, the term "light" used with "said light housing" was not originally used, but instead was first stated as "a decorative housing" in claim 27. Repeated terms used to designate the same part should be consistent in terminology.
7. Claims 38-46 are objected for depending on at least objected claim 37 for the error described above.
8. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 27, 28, 30-32, 35 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by HARRISON (US 6,112,887).
11. HARRISON discloses a decorative housing arrangement (figs.1-8) comprising: a decorative housing (car figure or "12" in col.2) being supported by an upper surface

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area of an elongate light assembly (fig.8 or "lighter 14" in col.2) with an upper portion (upper tail or trunk cover) of the car housing disposed between the light assembly (14) and an overhead structure (the roof of the car housing or user's hand col.3, lines 10-13); and a plurality of decorating components (col.2, lines 8-11) carried on an outer surface of the decorative housing (12); wherein said housing (12) includes a depending skirt (bottom mass including wheels of the car housing below the light assembly); wherein the decorating components include at least one decal or a plurality of decals, at least one having different indicia (col.2, lines 8-11), each of which is secured to an exterior surface of the light housing (12); wherein the overhead structure (roof of the car housing) inherently comprises a ceiling (of the car housing).

12. The recitation in claim 27 that "a decorative housing arrangement for covering an elongated light assembly that is configured and arranged for hanging from an overhead structure using a pair of spaced apart elongated suspension members" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

13. The functional recitation in claim 27 that "for covering an elongated light assembly that is configured and arranged for hanging from an overhead structure using a pair of spaced apart elongated suspension members" has not been given patentable weight because it is narrative in form. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the

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prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

14. In regards to claim 32, which recites "at least one indicia" met by HARRISON (col.2, lines 8-11). The process of the at least one indicia being "painted on an exterior surface of said light housing" is considered to be a method of forming at least a part of the device which is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Allowable Subject Matter

15. Claims 1-26 are allowed.

16. Claims 29, 33 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Claims 37-46 are objected for the minor errors (stated in paragraphs 5 & 6 above), but would be allowable if corrected.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DAVIS et al (US 5,188,449) show a decorative housing (12)

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being configured and arranged for being supported by an upper surface area (35 in fig.2 or 39 in fig.4) of an elongate light assembly (11) with an upper portion (97 in fig.2 or top portion of 13B in fig.4) of the housing (12) disposed between the light assembly (11) and an overhead structure (18,14) and a plurality of decorating components (col.5, lines 2-3) carried on an outer surface of the decorative housing (12). HISCOCK et al (US 6,158,157) show a hanging promotional article that includes an elongate light assembly (fig.5) with a hanging eyelet support (30a) and a decorative translucent housing (40) supported at its upper surface (41) by an upper surface of the light assembly (via 52, 53). DOUGLASS II (US 5,791,775) shows at least one suspended mobile housing (2) supported on a top surface of light assembly (bar 16) attached to an elongate suspension member (1). REYNOLDS et al (5,989,098) show a car-resembling member (fig.2) suspended from a light assembly (126-fig.2 or 70-fig.1). NAGEL et al (US 5,352,147) show a car model housing (12) incorporating a lighting assembly (30) and including paint or decals (18-25) on the exterior surface. MCDONALD et al (US 5,274,938) show a decorative housing supported by under its top surface by a fluorescent light assembly supported by suspension supports (figs.2-3). WARMAN (US 4,696,400) shows a kit that includes a container housing storing at least paint accessories.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (571) 272-2366. The examiner can normally be reached on 9-5:30 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alan Cariaso
Primary Examiner
Art Unit 2875

AC
April 4, 2005